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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,805	11/27/2006	Paul Morrison	P7088-4USD	6088
136 7590 03/03/2010 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004				
EXAMINER				
BATES, DAVID W				
ART UNIT		PAPER NUMBER		
3775				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553,805

Applicant(s)

MORRISON ET AL.

Examiner

DAVID W. BATES

Art Unit

3775

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-53, 58, 59 and 61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 48-53, 58, 59 and 61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Clarification of the Substance of the Interview

1. Applicant states in lines 9-11 on page 6 of the remarks of October 9, 2009, that at the interview, the Examiners agreed that in the absence of more relevant prior art, the application is in condition for allowance. This is incorrect. As is stated on the interview summary of October 8, 2009, further search *and consideration* would be required. *Only* the rejection of record was discussed, and agreed to be overcome. As such, an obviousness rejection in view of the prior art of record was not discussed at the interview.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 48-53 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard (WO 02/19919 A2).
4. Regarding claim 48, the claimed limitations have been taught by Leonard as demonstrated below:

A retractor useful in surgery, said retractor comprising

a main structural member (retractor 10, see arrangement of fig. 1) defining

a handle region (handle member 20),

a distal region (first elongate section 30), and

an intermediate region (portion 32), said intermediate region curving to define a low profile form having a concave lower side (side having outer surface 36) and a convex upper side (side having inner surface 38),

a light duct (elongate section 40) having an inlet end (end of the elongate member at 31) and an emission end (proximal end portion 44), the light duct ducting light received at the inlet end to the emission end,

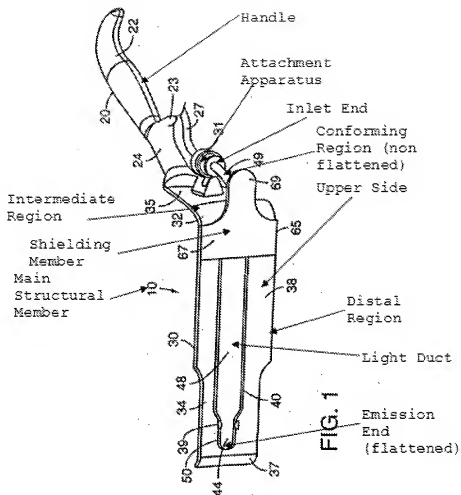
said light duct (elongate section 40), at least in a part away from the inlet end (end at 31), substantially conforming to the curving intermediate region of the main structural member (shaped region 49, more clearly seen in fig. 3) so as to maintain a low profile thereover whilst having the emission end (proximal end portion 44) emitting light the light duct has received and ducted towards a zone in which said distal region of the main structural member is being operated,

an attachment apparatus (connector 31) attaching to the light duct at or adjacent the inlet end (end of light duct 40 near 31) of the light duct and engaging with, or for engagement with, the main structural member (retractor 10), and

a shielding member (shield member 65) covering and protective of all of the light duct over the curving intermediate region and the distal region (see fig. 7, the shield 65 is shown to curve upward to conform to the shaped portion 49 of the light duct 40 in the intermediate region; all of the light duct is covered from at least the direction of view as seen in fig. 1; at least a portion of the distal region of the light duct is covered and protected by the shielding member 65) of the main structural

member, said shield member at least attaching to the main structural member
(attachment to retractor 10 as seen in fig. 1),

the emission end of the light duct (elongate section 40) being substantially of a flattened section of lesser height than the inlet end of the inlet duct (seen at 44) for conforming to the low profile form of the intermediate region and distal region of the main structural member, the light duct splaying to said flattened section from a non flattened form at the inlet end of the light duct (see pp. 10, line 30 – pp. 11, line 2).



Leonard does not specifically teach the **intermediate and distal region curving continuously from the handle region.**

However, Leonard has made obvious the instant invention. It would have been an obvious matter of design choice to change the device of Leonard from having two curved regions (32 and 37) to having a single, continuously curved region. Applicant has stated that the advantage of such a design is that it provides a "low profile" design

(pp. 3, line 17-22) acceptable for use in a "hip or other joint surgery" (pp. 1, lines 20-21).

These are not advantages over the device of Leonard since Leonard also teaches (or alternatively, suggests) these same advantages:

- Leonard is designed for use in a pelvic surgery, and is capable of use in surgery on a joint (retracting tissue in a surgery of the hip)
- Applicant has defined low profile to mean: "to provide less of a profile transversely down through the curved region than is provided in other directions." Using a first interpretation of Applicant's definition, the "downward" dimension in the curving region is smaller than the other dimensions (the thickness of the device is less than the width and length). The distance from the upper to lower surfaces of the curved regions of Leonard is indeed less than the other dimensions. Therefore the device of Leonard is of low profile.
- In an alternative interpretation of "low profile", Examiner believes Applicant means the distance from the bottom most point to the top most point of the device to be the profile (viewed from the side, when in use). MPEP 2125 states that proportions of features in a drawing are not evidence of actual proportions when drawings are not to scale. The drawings of Leonard are not identified as being to scale. Substituting a shorter distal region in Leonard (e.g. ending immediately after the shield 65) would be within the scope of the invention of Leonard, and would provide for a low profile in a possible alternative interpretation of the term "low profile". The distal region is serving as a retractor

blade. It is well known in the art to substitute a short retractor blade for a long one in a situation where a shallow surgery is conducted. Doing so would be the application of a known technique to a known device ready for improvement to yield the predictable result of allowing the device to be used in a more shallow surgery.

5. Regarding claim 49, the above claimed limitations of claim 48 have been suggested by Leonard. Further, the light duct (elongate section 40) is taught to be made of a transparent plastic (pp. 11, line 15). Further, the attachment apparatus (connector 31) is shown to be integrally molded with the light duct.
6. Regarding claim 50, the above claimed limitations of claim 48 have been taught by Leonard. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the single molded attachment apparatus and light duct with a light duct and apparatus which are made of two components since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.
7. Regarding claim 51, Leonard has suggested the above claimed limitations of claim 48, and further has taught the connector 31 being adapted to receive an optical cable 27 (pp. 9, lines 6-10).
8. Regarding claims 52 and 53, Leonard discloses the claimed invention, but does not specifically the claimed ranges. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the invention of Leonard

within the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

9. Regarding claim 58, the above claimed limitations of claim 48 have been suggested by Leonard. Further, Leonard has demonstrated the shielding member (65) conforming *closely* (relative term) to the flattened section of the light duct (see arrangement of fig. 3, lower portion 67 of the shield member 65 is seen to closely conform to the flattened section 44 of the light duct 40).

10. Claims 59 and 61 are rejected under 35 U.S.C. 103(a) as being anticipated by Leonard in view of Wilder et al. (US 4,562,832).

11. Regarding claim 59, Leonard has suggested the above claimed limitations of claim 48, but has not specifically taught a light and battery carried by the main structure. However, Wilder et al. suggest a structural member 11 having handle 13, curved region 14, and distal region 12; light ducting means 16 with inlet 16A and emission zone 16B; and shield 17, that includes a light source 23, and a provision for mounting battery (see col. 6, lines 52-61) which can be on the main structure in order to eliminate the need to couple the assembly to a remote light source. It would have been obvious to one with ordinary skill in the art at the time of the invention to incorporate the light source and battery of Wilder et al. with the device of Leonard to predictably eliminate the need to use the assembly with a remote light source.

12. Regarding claim 61, the combination of Leonard in view of Wilder et al. has suggested the above claimed limitations of claim 59. However, this combination has but not specifically taught the device having a switch. It would have been obvious to one with ordinary skill in the art at the time of the invention to use a switch to turn on and off a light source. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention to incorporate a switch with the combination of Leonard in view of Wilder et al. to simplify the application of power to the light source of Wilder et al.

Response to Arguments

13. Applicant's arguments with respect to claims 48-53 and 58-61 have been considered but are moot in view of the new grounds of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID W. BATES whose telephone number is (571)270-7034. The examiner can normally be reached on Monday-Friday 9:00AM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. W. B./
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775